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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERICH KAST, HANS-JOACHIM,
and PETER WEILAND

Appeal 2008-1532
Application 10/686,037
Technology Center 3700

Oral Hearing Held: Tuesday, September 16, 2008

Before TONI R. SCHEINER, DONALD E. ADAMS, and
ERIC B. GRIMES, *Administrative Patent Judges*

ON BEHALF OF THE APPELLANTS:

FRIEDRICH KUEFFNER
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The above-entitled matter came on for hearing on Tuesday, September 16, 2008, commencing at 9:28 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Kevin Carr, Notary Public.

1 JUDGE SCHEINER: Good morning.

2 MR. KUEFFNER: Good morning.

3 My name is Friedrich Kueffner. I'm representing the applicant in this
4 case, which concerns a medical implant to be placed between two vertebrae
5 after the disk surgery. And this implant, according to the invention, has a
6 specific shape with the most important feature being the fact that the thickest
7 portion of the implant is in the rear third of the implant. Now, the
8 examiner has cited a French reference to Bernard, which does show an
9 implant which looks very similar. It also has a thicker portion in one-third
10 of its length. But the implant of the reference is to be placed in the reverse
11 orientation. And, now, the examiner says you just have to turn it around
12 and, then, you arrive at the invention. But here, we are saying that there is
13 no motivation in the reference to do that. The implant only serves its
14 function as intended if it's placed into the location for the implant as
15 intended. As a matter of fact, the reference specifically says that it is – in –
16 with this type of surgery, it is happening many times that the implant is put
17 in place – they're saying they want to provide an implant in which the
18 position is correct. And they want to avoid incorrect positioning of the
19 vertebrae – relative to the vertebrae. And, therefore, we submit that the
20 reference teaches that only this position that is described in the reference is
21 the one that should be looked at. And, therefore, the reference actually – he
22 submits is teaching away from the invention.

23 JUDGE GRIMES: Well, I think the problem that we're having with
24 your argument is that it seems to depend on the intended use of the article
25 that's being claimed. Whereas, when we're comparing a claimed device to
26 the prior art, we're just looking at the structural limitations that were written

1 into the claim and comparing those to the prior art. And here, you know,
2 which side is ventral and which side is dorsal depends on how you're – how
3 it's intended to be put into the spine. And, so, it – there's nothing structural
4 about your device that says, "This end is the ventral side. This is the dorsal
5 side." There's just one side and the opposite side. And it's the same with
6 the prior art device.

7 MR. KUEFFNER: But the reference does specify which side is
8 which.

9 JUDGE GRIMES: I understand. But, again, that's with respect to the
10 intended use of the device. It's intended to be placed in a certain orientation.
11 And yours is intended to be placed in the spine in a certain orientation.

12 MR. KUEFFNER: Yeah. That's –

13 JUDGE GRIME: But when we look at the two devices, they both
14 have a maximum height that is within one-third of the length from an end.
15 And which is the near end and which is the far end is only relevant when the
16 device is actually placed into a patient, not when it's just sitting on a shelf.

17 MR. KUEFFNER: Yeah. But we are submitting that an implant is
18 only an implant once it is in its intended position. And one should look at
19 the environment together with the device in this particular case. It's not
20 sufficient to look just at the structural features separately by themselves.
21 The –

22 JUDGE GRIMES: But if you were intended to claim an implant in
23 place in a patient, then wouldn't you have to write that as a method claim so
24 that you would have a method of inserting the implant in a particular
25 orientation into a particular place? If you're just claiming a device, it's –

1 your claim is to the device, not the device in a particular position in a
2 patient. Correct?

3 MR. KUEFFNER: Yeah. A method claim would have been the way
4 to go, I have to admit.

5 JUDGE SCHEINER: I have a question about claim 6 actually. The
6 implant, in accordance with claim 1, where the implant is configured to be
7 placeable in a half-space of an intervertebral space, together with another
8 implant having mirror symmetry – where is of the plane of symmetry there?
9 Is it ventral/dorsal or is it side to side or horizontal?

10 MR. KUEFFNER: That is illustrated in the drawings.

11 JUDGE SCHEINER: And it --

12 MR. KUEFFNER: And the way it is intended is that they are side by
13 side.

14 JUDGE SCHEINER: Side by side. I didn't see that in the drawing.

15 JUDGE GRIMES: Is that Figure 7 of the newest set of drawings
16 you're referring to?

17 MR. KUEFFNER: Figure 7. Yes.

18 JUDGE SCHEINER: Okay.

19 MR. KUEFFNER: That constitutes my presentation. Is there
20 anything else?

21 JUDGE SCHEINER: Anything further?

22 JUDGE GRIMES: No more questions.

23 JUDGE SCHEINER: I don't have anything further. Thank you for
24 coming in.

25 MR. KUEFFNER: Thank you very much for --

1 (Whereupon, at approximately 9:44 a.m., the proceedings were
2 concluded.)

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